

REMARKS

Claims 46 and 55 are amended, no claims are canceled, and no claims are added; as a result, claims 36-42, 45-49, and 51-56 are now pending in this application.

No new matter has been added by the amendments to claims 46 and 55. Claim 46 is amended to delete the phrase, “to facilitate a transaction by a network-based transaction facility, the method” from the preamble of the claim. Claim 55 is amended merely to add the word “non-transitory” to the preamble of the claim.

Petition to Make Application Special - Granted in the Application

It is respectfully noted that a Petition to Make Special was filed in the application on August 21, 2006, and was granted on February 27, 2008.

In view of the status of the application as Special, Applicants’ representatives wish to work with the Examiner to gain an allowance in the application as quickly as possible. Based on a review of the claims now pending in the application, and on a review of the rejections cited in the Office Action, it is believed that, for at least the reasons stated in this response, the claims are patentable, and a Notice of Allowance including all pending claims in the application is respectfully requested.

Request for Telephone Interview

If the Examiner does not agree that the application is fully in condition for allowance, and in view of the status of the application as Special, it is respectfully requested that that the Examiner contact the Applicants’ representatives and grant the courtesy of a telephone interview in order to proceed with prosecution of the application.

The Rejection of Claims Under § 112

Claims 46-49 and 51-54 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Office Action has rejected claims 46-49 and 51-54 wherein according to the Office Action, “The scope of the independent claim 46 is unclear because it is unclear how the limitations fulfill the stated purpose in the preamble.”¹

For at least the reasons stated in the response² previously filed in the present application, Applicants do not agree with these statements. Further, Applicants do not agree that claim 46 is unclear or that claim 46 does not meet the requirements of 35 U.S.C. § 112, second paragraph.

However, in order to proceed to an allowance of claims 46-49 and 51-54 in the present application, the preamble of claim 46 is now amended to delete the phrase “to facilitate a transaction by a network-based transaction facility, the method.” It is respectfully submitted that claim 46, at least as now amended, and claims 47-49 and 51-54, which depend from independent claim 46, comply with the requirements of 35 U.S.C. § 112, second paragraph.

Withdrawal of the 35 U.S.C. § 112, second paragraph rejection, and allowance of all claims now pending in the application are respectfully requested.

The Rejection of Claims Under § 103

Claims 36-42, 45-49, and 51-56.

Claims 35-42, 45-49 and 51-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Esposito et al. (U.S. Patent No. 6,587,838, hereafter Esposito) in view of Kopelman et al. (U.S. Patent No. 7,373,317, hereafter Kopelman), Offutt Jr. et al. (U.S. Publication No. 2002/0184059A1, hereafter Offutt), Spiegel et al. (U.S. Patent No. 6,466,919B1, hereafter “Walker” in view of the notes below), and Van Horn et al. (U.S. Patent No. 6,934,690, hereafter Van Horn).

Claim 35 was previously cancelled in the application, and so any rejection of claim 35 is moot. The 35 U.S.C. § 103(a) rejection of claims 36-42, 45-49, and 51-56 is respectfully traversed.

It is respectfully noted that U.S. patent 6,466,919 B1 is included in the Office Action in the statement of the rejection of claims 36-42, 45-49, and 51-56. The Office Action refers to this patent as “Spiegel et al.” However, U.S. patent 6,466,0919 indicates that Jay S. Walker, Daniel

¹ See the Office action in the last paragraph on page 2.

² See the response filed by Applicants’ Representatives using the USPTO’s electronic filing system EFS-Web on January 28, 2010 in the present application at page 10-11 under the heading “§ 112 rejection of the Claims.”

E. Tedesco, and James A Jorasch are the inventors as listed on the issued patent. In addition, in the Notice of References Cited sheet included in the Office Action, row G lists US-6,466,919 patent as issued to “Walker et al.”

Therefore, Applicants’ representatives have proceeded in this response based on the assumption that the patent intended to be used by the Examiner in the 35 U.S.C. § 103(a) rejection of claims 36-42, 45-49, and 51-56 is the U.S. 6,466,919 patent to Walker et al. If this assumption is incorrect, clarification or correction of the basis for the rejection is respectfully requested, and the opportunity to review and to respond to any such correction or clarification that may be provided is hereby reserved. The U.S. 4,466,919 patent will hereinafter be referred to as the “Walker” document.

Claims 36-42, 45-49, and 51-56 are not obvious in view of the proposed combination of Esposito, Kopelman, Offutt, Walker, and Van Horn because this proposed combination fails to disclose or suggest all of the subject matter included in any given one of claims 36-42, 45-49, and 51-56. The arguments provided by Applicants’ representatives in the previous response filed in the present application³ are maintained in this response, because the proposed combination of Esposito, Kopelman, Offutt, Walker, and Van Horn still fails to disclose or suggest all of the subject matter included in any given one of claims 36-42, 45-49, and 51-56, and therefore the Office Action fails to meet the required burden to establish a *prima facie* case of obviousness in the rejection of claims 36-42, 45-49, and 51-56.

By way of illustration, independent claim 35 recites,

the at least one back-end server operable to generate a commingled list of items offered for sale based on the request and on data stored within the database, wherein the commingled list includes items being offered for sale by any combination of an auction-type price setting process and a fixed price setting process; and

wherein the commingled list includes items being offered for sale by any combination of an auction-type price setting process and a fixed price setting process, and wherein if the request includes a specified transaction type, the at least one back-end server is operable to filter the comingled list to include only items offered for sale that have a type of item in the sale type field for

³ See the response filed by Applicants’ Representatives using the USPTO’s electronic filing system EFS-Web on January 28, 2010 in the present application.

the item offered for sale that matches the specified transaction type.

The Office Action fails to point out in any of the documents cited in the rejection of claim 36 where there is a disclosure or suggestion of this subject matter. Instead, the Office Action attempts to avoid giving this subject matter patentable weight based on *In re Harza*. 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

However, as noted in Applicants' response previously filed in the present application⁴, the ruling in *In re Harza* relates to duplication of parts, and is completely inapplicable to the subject matter included in claim 36 of the present application. The arguments provided in the Applicants' above mentioned previously filed response are therefore maintained in this response, and are provided once again here for convenience:

"The Office Action improperly applies In re Harza in an attempt to avoid giving patentable weight to the language of the claims."

The Office Action refers to *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) in an improper effort to avoid giving patentable weight to the language of the currently pending claims in the application. For example, the Office Action states:

The following limitations are not given patentable weight because repetition of a method step is not considered to have patentable novelty (In re Harza):

"accepting at the network-based transaction facility a second requirement from the client machine, the second require to sort the commingled list by a specific criteria, wherein the specific criteria includes a specific transaction type of the plurality of transaction types;

using the sales type field from the items table, looking up in the items table the specified transaction type to determine if any of the items from the commingled list meet the requirements for the specified transaction type by

⁴ See the response filed by Applicants' Representatives using the USPTO's electronic filing system EFS-Web on January 28, 2010 in the present application at pages 15-17.

comparing the specified transition type to the sales type field in the items table;

generating a sorted list, the sorted list sorted to include only items offered for sale by the seller that meet the specified transaction types included in the second request; and

communicating across the network to the client machine and sorted for display a the client machine.”

These statements as provided in the Office Action are respectfully traversed. First, the Office Action is required to give patentable weight to each and every word included in the claims.

The Office Action fails to explain how the case *In re Harza* provides permission for the Examiner to not give patentable weight to the above-quoted language as included in the claims of the application.

Further, it is respectfully submitted that *In re Harza* concerns *duplication of parts*, and does not address “method steps” as suggested by the Office Action. The following is taken from the MPEP quoting *In re Harza*:

B. Duplication of Parts

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a “web” which lies in the joint, and a plurality of “ribs” projecting outwardly from each side of the web into one of the adjacent concrete slabs. The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). **Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.**)⁵

(Emphasis added)

Further, the following is taken from the language of *In re Harza*:

⁵ See Manual of Patent Examining Procedure, Eight Edition, august 2001, Latest Revision July 2008 at Section 2144.01.

The board, in affirming the examiner, stated that the claims were unpatentable over Gardner alone and that it was not “necessary to rely on either Roberts or Schurman.

...

The only distinction to be found in the recitation in claim 1 of the plurality of ribs on each side of the web whereas Gardner shows only a single rib on each side of the web. It is well settled that the **mere duplication of parts** has no patentable significance unless a new and unexpected result is produced, and we are of the opinion that such is not the case here.⁶

(Emphasis added).

Thus, *In re Harza* relates to *duplication of parts*, but does not mention “method steps”, as suggested in the Office Action. Further, as shown in *In re Harza*, the court did not suggest that the subject matter of claim 1 did not give patentable weight, as suggested by the Office Action. Instead, *In re Harza* indicated that duplication of parts in a claim does not provide patentable significance unless a new and unexpected result is produced. The patentable significance of the duplicate part was viewed relative to the disclosure of the cited art, and was not merely discarded as having no patentable weight merely for being a duplication of parts.

In other words, the court did not say that this subject matter did not give patentable weight in view of the cited reference Gardner, but that the duplicate of parts did not *provide patentable significance* over Gardner. This is quite different form not giving claimed subject patentable weight to claimed subject matter. That is, *In re Harza* does not mean that subject matter does not need to be considered at all in view of any prior art, as is being suggested by the Office Action. Thus, the Office Action is required to give patentable weight to the subject matter included in the claims as pending in the Office Action.

Further, the Office Action fails to show how the subject matter of claim 46 is duplicated, and thus would not be patentably significant in view of the documents cited in the Office Action, even if the ruling in *In re Harza* were applicable to the subject matter of claim 46, or specifically how any “duplication” is present in the claims.”

⁶ See *In re Harza* at 671.

Thus, any rejection of the subject matter of claim 36 based on *In re Harza* is improper, and the Office Action must give patentable weight to all of the features included in independent claim 36. Because the Office Action has failed to do so, the Office Action fails to meet its burden for establishing a *prima facie* case of obviousness with respect to independent claim 36.

Independent claim 36 includes additional subject matter that is not disclosed or suggested by the proposed combination of Esposito, Kopelman, Offutt, Walker, and Van Horn. For example, independent claim 36 also includes:

the at least one back-end server operable to search a database maintained by the network-based transaction facility, wherein the network-based transaction facility includes a database engine server coupled to at least one engine server database including a user table, the engine server database includes an items table that is linked to the user table and that includes a sellers items table and a bidders items table, wherein the items table includes a number of fields for each of a plurality of records that describe an item offered for sale via the network-based transaction facility, **wherein at least one of the number of fields includes a sale type field operable to record a type of item that indicates a price-setting process by which a price for the item relevant to the record associated with the item being offered for sale is established, the database including at least one item offered for sale using an auction-type price setting process and at least one item offered for sale using a fixed price setting process.** (Emphasis added).

There is no disclosure or suggestion in any of the documents cited in the 35 U.S.C. § 103(a) rejection as presented in the Office Action, of the subject matter as quoted above and as included in independent claim 36. The Office Action admits that Esposito does not explicitly disclose this subject matter.⁷ Instead, the Office Action refers to “Spiegel” [Walker] and Van Horn in an attempt to remedy these deficiencies in Esposito. However, the cited portion of Walker only recites:⁸

If the buyer's individual CPO is accepted first, the status of individual CPO is changed to "completed" and the terms of each

⁷ See the Office Action at page 5,

⁸ See Walker at column 3, lines 45-49.

aggregate CPO is adjusted to reflect the removal of the individual CPO that was simultaneously included in the aggregate CPO.

However, this portion of Walker fails to disclose or suggest the subject matter quoted above from independent claim 36 and missing from Esposito.

Further, the Office Action refers to Van Horn in the rejection of independent claim 36. However, as already pointed out in a previously filed response in the present application,⁹ the cited portion of Van Horn recites:

The seller's screen 800 includes a name field 801, and address field 802, a goods for sale field 803, a maximum quantity field 804, and a description of goods field 805. . . . The goods for same field 803 allows the seller to enter a name for the goods being sold¹⁰

As already pointed out in the above mentioned previously filed response in the present application, this portion of Van Horn also fail to disclose or suggest the subject matter of independent claim 36 as quoted above and missing from Esposito.

The Office Action appears to admit this, but attempts to remedy these deficiencies by stating:

“The ordinary practitioner would have seen it as obvious from his own knowledge and these disclosures to establish a ‘database which includes an items table, the items table defining a plurality of fields for each of the plurality of items being offered for sale, including a sale type field for each given item being offered for sale, wherein the sale type field records the price setting process for each of the plurality of items being offered for sale.”

However, the Office Action has provided no document or other evidence to support these statements regarding this subject matter as included in independent claim 36, and has in effect admitted in the Office Action that there is no such disclosure or suggestion in any of the documents cited in the statement of 35 U.S.C. § 103(a) rejection of claims 36-42, 45-49 and 51-56.

⁹

¹⁰ See Van Horn at column 11, lines 22-29.

Instead, the Office Action merely states that these features of claim 36 would have been “obvious to the ordinary practitioner”. However and in contrast to this, these features are some of the several features of independent claim 36 that are non-obvious and that provide patentable subject matter to independent claim 36, especially in view of the documents cited in the 35 U.S.C. § 103(a) rejection of independent claim 36 in the Office Action, because this subject matter is not found in the prior art. The statements that this subject matter would have been “obvious to the ordinary practitioner” appears to be using impermissible hindsight in the belief that this subject matter, as now described in the present specification and as claimed for example in independent claim 36, would have been obvious to the ordinary practitioner.

Further, Applicants respectfully disagree with these statements made in the Office Action, and submit that since the Office Action does not recite a reference that discloses this subject matter of independent claim 36, the subject matter is apparently within the personal knowledge of the Examiner. Thus, the Examiner is taking official notice of this subject matter as recited in independent claim 36.

Applicants traverse the taking of official notice, and request that the Examiner provide a reference that describes this subject matter as included in claim 36. If the Examiner cannot provide such a reference, Applicants request that the Examiner submit an affidavit as required by MPEP § 2144.03. If the Examiner cannot provide an affidavit, Applicants request withdrawal of the rejection and reconsideration and allowance of independent claim 36.

Otherwise, and for at least the reasons stated above, independent claim 36 is not obvious, and is patentable, in view of the documents cited in the Office Action used in the statement of the 35 U.S.C. § 103(a) rejection of independent claim 36.

For reasons analogous to those stated above with respect to independent claim 36, the proposed combination of documents cited in the Office Action also fails to disclose or suggest all of the subject matter included in either one of independent claims 46 and 55. Further, as claims 37-42, 45, 47-49, 51-54, and 56 depend from one of independent claims 36 and 46, these claims are also non-obvious, and are patentable, in view of the 35 U.S.C. § 103(a) rejection proposed in the Office Action.

The Office Action fails to meet its required burden to establish a *prima facie* case of obviousness with respect to claims 36-42, 45-49, and 51-56, and so reconsideration and

withdrawal of the rejection and allowance of claims 36-42, 45-49, and 51-56 are respectfully requested.

Claim 48

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito et al. (U.S. Patent No. 6,587,838) in view of Kopelman et al. (U.S. Patent No. 7,373,317), Offutt Jr. et al. (U.S. Publication No. 2002/0184059A1), Spiegel et al. (U.S. Patent No. 6,466,919) and Van Horn et al. (U.S. patent No. 6,934,690) as applied to claim 46 above, and further in view of O'Neill et al. (U.S. Patent No. 5,987,440, hereafter O'Neill).

The 35 U.S.C. 103(a) rejection of claim 48 is respectfully traversed.

Claim 48 depends from independent claim 46, and so includes all of the subject matter included in independent claim 46, and more. For at least the reasons stated above with respect to independent claim 46, any proposed combination of Esposito, Kopelman, "Spiegel" [Walker], Offutt, and Van Horn fails to disclose or suggest all of the subject matter included in claim 48. The addition of O'Neill fails to remedy these deficiencies in the proposed combination of Esposito, Kopelman, Offutt, Walker, and Van Horn. Thus, the proposed combination of Esposito, Kopelman, Offutt, Walker, Van Horn, and O'Neill¹¹ fails to disclose or suggest all of the subject matter included in claim 48, and so claim 48 is not obvious in view of the proposed combination of Esposito, Kopelman, Offutt Jr., and O'Neill.

Therefore, the Office Action fails to meet its burden for establishing a *prima facie* case of obviousness with respect to claim 48, and so reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection, and allowance of claim 48 is respectfully requested.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any

¹¹ Applicants do not admit or agree that any proposed combination or combinations of Esposito, Kopelman, Offutt, Walker, Van Horn, and O'Neill are possible.

reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION


Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited and encouraged to telephone the undersigned at (612) 371-2132 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(612) 371-2132

Date November 8, 2010

By 
Robert B. Madden
Reg. No. 57,521